

REMARKS

Claims 1, 2, and 4-12 are all the claims pending in the application. By this Amendment, applicant has amended claims 1, 5 and 10. Applicant respectfully submits that no new matter has been added.

Rejection Under 35 U.S.C. § 112

Claims 1-10 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. Claims 1-10 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. The Examiner alleges that it is not clear how particular filtering criteria can be specified by a private network because “a network is an abstract entity and it is not clear how a network and not a user can specify filtering criteria.” By this Amendment, Applicant has amended claims 1 and 10 to improve clarity and respectfully submits that amended claims 1 and 10 are in compliance with 35 U.S.C. § 112, first and second paragraphs. Accordingly, Applicant respectfully requests the Examiner to withdraw the § 112 rejections.

Rejections Under 35 U.S.C. § 103(a)

Claims 1-2, 4 and 8-10

Claims 1-2, 4 and 8-10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Pfleeger (Charles P. Pfleeger, “Security in Computing”, 2nd edition, 1996, ISBN: 0133374866) and Chapman (D. Brent Chapman and Elizabeth D. Zwicky, “Building Internet Firewalls”, ISBN: 1565921240, 1995) in view of Gupta et al. (U.S. Patent No. 6389532).

Independent claim 1 (as amended) requires, *inter alia*:

temporarily storing a multimedia data stream received from said computer network and addressed to a user terminal of said user terminals connected to said private network in response to an access request from said user terminal in order to perform filtering based on data content of said multimedia data stream, said filtering authorizing or blocking transmission of said multimedia data stream to said terminal as a function of particular criteria provided from said private network and applied to the multimedia data stream received at said private access node, and

analyzing a signature included in said multimedia data stream for the purpose of said filtering.

Applicant respectfully submits that Pfleeger does not teach or suggest filtering “based on the data content” which comprises said multimedia data stream” but instead is directed to packet filtering for routing purposes (to improve the QoS). Filtering in Pfleeger is not achieved based on the data content in the packet.

Applicant further submits that Pfleeger does not teach or suggest that the filtering criteria is “provided from said private network”, as opposed to filtering rules that are specified by the public network(s) to which the private network is linked or by a computer network provider (ISP). The Examiner alleges that “the limitation of specifying particular filtering criteria by the private network is implicit” because “user terminals disclosed by Pfleeger to be inside of the firewall are terminals connected to the private network” and the main purpose of firewalls is to restrict traffic to private networks in order to protect private resources.”

First, Applicant notes the Examiner has not provided any analysis or reason why “filtering authorizing or blocking transmission of said multimedia data stream to said terminal as

a function of particular criteria provided from said private network” is inherent in the cited references. The fact that the user terminals are in a private network, or that firewalls restrict traffic to private networks to protect private resources, does not mean “particular criteria [are] provided from said private network”. In order to establish inherency, extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the reference and that persons of ordinary skill would so recognize. In re Robertson, 169 F.3d 743, 745 (Fed. Cir. 1999). Moreover, the Examiner is required to provide a basis in fact and/or technical reasoning to support his argument that the inherent characteristics are present in the teachings of the applied reference. Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

Second, it appears that the Examiner is combining Pfleeger and Chapman, and arguing that a feature of claim 1 is inherent within the combination. Inherency and obviousness are entirely different concepts. In re Rinehart, 531 F.2d 1048, 189 U.S.P.Q. 143 (CCPA 1976). Inherency of an advantage and its obviousness are different questions; that which may be inherent is not necessarily known; obviousness cannot be predicated on that which is unknown. In re Adams, 53 CCPA 996, 356 F.2d 998, 148 U.S.P.Q. 742 (1966). Accordingly, it is incumbent upon the Examiner to explain why features of the claimed invention he alleges are inherent would have been obvious to one of ordinary skill in the art.

Neither Gupta nor Chapman compensates for the deficiencies of Pfleeger. Accordingly, Applicant respectfully submits that independent claim 1 would not have been obvious under 35 U.S.C. § 103(a) because Pfleeger, Gupta, and Chapman, alone or in combination, do not teach or suggest all of the features of claim 1. Therefore, Applicant respectfully requests the Examiner to

withdraw the rejection of independent claim 1, and dependent claims 2, 4 and 8-9 at least by virtue of their dependency.

Independent claim 10 recites features similar to independent claim 1 except in apparatus form. Applicant respectfully submits that claim 10 is patentable under similar reasoning as applied to independent claim 1. Accordingly, Applicant respectfully requests the Examiner to withdraw the rejection of independent claim 10.

Claims 5-7

Claims 5-7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Pfleeger (Charles P. Pfleeger, "Security in Computing", 2nd edition, 1996, ISBN: 0133374866) alternatively in view of Gupta et al. (U.S. Patent No. 6389532) and further in view of Cotton (U.S. Patent No. 6330590). Applicant respectfully traverses the rejection.

Claim 5 (as amended), requires:

The method claimed in claim 4, wherein temporarily delayed data, which comprises said multimedia data stream stored in the determination of conformance, is retained to enable a further check in the event of non-conformance, either in respect of data received on detection of non-conformance, in which case the multimedia data stream is interrupted, or in respect of all data of the multimedia data stream received, without said multimedia data stream being interrupted.

The Examiner concedes that neither Pfleeger nor Gupta teaches or suggests "temporarily delayed data... is retained to enable a further check in the event of non-conformance." However, the Examiner asserts: "*Cotton* teaches counting, for control purposes, the number of times that

data of a particular content is received and retaining non-conformance data to enable interruption of a subsequently received data stream.”

Cotton is directed, generally, to a system and method for processing and eliminating unwanted bulk e-mail messages. Specifically, Cotton teaches a method whereby SPAM is detected when sent to several e-mail addresses. See Cotton, Col. 3, Lines 47-50. According to the detection process taught in Cotton, each e-mail is reduced to the content of its message and then a signature identification code is created from that remaining portion of the message. The “abbreviated signature” is compared (with an in-line Signature Comparator) to other signature identification codes created from other messages. See Cotton, Col. 3, line 49 to Col. 4 line 38. Cotton teaches that the SPAM detection system could be employed in the auditing or control of flow of e-mail traffic. See Cotton, Col. 4, lines 13-29 and 38-52. Accordingly, it is clear that the cited portions of Cotton do not teach or suggest that the text of the e-mails is retained for future comparisons, but rather teaches retaining abbreviated signature codes. Further, it is clear that Cotton does not teach or suggest “counting, for control purposes, the number of times that data of a particular content is received” as alleged by the Examiner.

Applicant respectfully submits that claims 5-7 would not have been obvious under 35 U.S.C. § 103(a), because Pfleeger, Gupta and Cotton, alone or in combination, do not teach or suggest all of the features of the claims. Accordingly, Applicant respectfully requests the Examiner to withdraw the rejection of claims 5-7.

AMENDMENT UNDER 37 C.F.R. § 1.116
U.S. Application No. 09/873,357

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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